

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

2875.0170001

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Application Number

10/728,192

Filed

December 4, 2003

First Named Inventor

BUER et al.

Art Unit

2437

Examiner

Williams, Jeffery L.

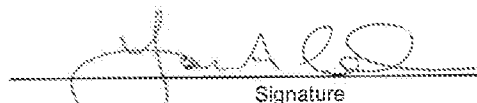
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)☐ attorney or agent of record.
Registration number _____☒ attorney or agent acting under 37 CFR 1.34.Registration number if acting under 37 CFR 1.34 50,633

Signature

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April 14, 2010

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

BUER *et al.*

Application No.: 10/728,192

Filed: December 4, 2003

For: **Tagging Mechanism for Data Path
Security Processing**

Confirmation No.: 7312

Art Unit: 2437

Examiner: Williams, Jeffery L.

Atty. Docket: 2875.0170001

Arguments to Accompany the Pre-Appeal Brief Request for Review

Mail Stop: AF

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants hereby submit the following Arguments, in five (5) or less total pages, as attachment to the Pre-Appeal Brief Request for Review Form (PTO/SB/33). A Notice of Appeal is concurrently filed.

Arguments

Applicants' arguments in the Amendment and Reply under 37 C.F.R. §1.111 filed on July 6, 2009 (hereinafter "Reply"), were not properly considered or responded to by the Examiner in the final Office Action mailed October 14, 2009 ("Final Office Action").

1. Objection to the Specification and Rejections under 35 U.S.C. §112

In the Final Office Action, the Examiner objected to the specification as failing "to provide proper antecedent basis for the recitations (or essentially similar recitations) 'a user-specific type field.'" The Examiner further rejected claims 5-7, 9, 18, 30, 35, 36, 38 under 35 U.S.C. 112, second paragraph as being indefinite. Specifically, the Examiner stated that "the claim recitation of '... a user-specific type field ...' or '... a user-specific Ethernet type' lacks a defined and customary meaning to those of ordinary skill in the art and the applicant's fail to define 'a user-specific type field', thereby rendering the scope of the claims indeterminate." (Final Office Action, p. 6). Applicants traverse.

As discussed in MPEP 2173.05(e), "[t]he mere fact that a term or phrase used in the claim has no antecedent basis in the specification disclosure does not mean, necessarily, that the term or phrase is indefinite. There is no requirement that the words in the claim must match those used in the specification disclosure. Applicants are given a

great deal of latitude in how they choose to define their invention so long as the terms and phrases used define the invention with a reasonable degree of clarity and precision.”

Paragraph [0060] of Applicants’ specification recites:

When the security processor receives a packet 60 with the security processor’s address in the DA field of the outer header 66, the security processor may check the Ethernet type field 62 to determine how to process the packet header. A company such as Broadcom Corporation may have a unique registered Ethernet type 62 that is used to define in-band packet communication.

Thus, the specification describes that a user (e.g., “Broadcom”) may have a unique registered Ethernet type 62. That is, this unique registered Ethernet type is user-specific. Accordingly, the term “user-specific Ethernet type field” is defined with reasonable clarity and precision and is therefore not indefinite.

The Examiner further objected to the specification as failing “to provide proper antecedent basis for the recitations of ‘pre-populated with an address ...’ and ‘the pre-populated header’ as found recited within claim 17” and recitations (or essentially similar recitations) in claims 1, 17, 26, and 37 related to a destination address of the second Ethernet packet being an address of the originating device. (Final Office Action, pp. 2-3.)

The Examiner similarly rejected claims 1-7, 9, 13-33 and 35-40 under 35 U.S.C. 112, first paragraph as failing to comply with the written description requirement stating that “Applicant has not clearly pointed out where the new (or amended) claim is supported, nor does there appear to be a written description of the claim limitations in the application as filed” and under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner stated that:

the examiner interprets the applicant’s amendments in light of the applicant’s arguments, wherein the applicant asserts that the claimed features are supported within the applicant’s disclosure (e.g., par. 64, 65) within the context of configuration packets for the configuration of a security processor. However, the examiner points out that security processor configuration and IPSec communication are distinct processes. Thus, the scope of these claims is indefinite, as it is unclear what process the applicant is attempting to claim.

Applicants respectfully disagree with the Examiner’s understanding of the specification.

As described in Applicants' specification, "CLASS-F packet 72 may be used to send configuration packets and data packets to the security processor." (Spec., ¶ [0064].) "Each device builds the packet that will be sent back to the device. The security processor may then simply strip the outer header and the security header (F, C, MCW), modify the packet data (SAP, MAP, MEP, DATA), if applicable, and send the inner packet back to the device." (Spec., ¶ [0065].) "The inner Ethernet header is a header that may be used to return the packet to the original sender. Thus, the DA [destination address] in the inner Ethernet header may be the address of an Ethernet controller that sent a configuration packet or data packet to the security processor." (Spec., ¶ [0064].)

Applicants' specification further describes that "a previously encapsulated packet may be sent to the security processor 810 using the CLASS-FAMILY=security packet type. This packet will be encrypted/authenticated by the security processor 810 using the security association data ("SADa") stored either in local memory or passed in-band with the packet." (Spec., ¶ [0135].)

Thus, the specification provides proper antecedent basis and written description support for the elements of claims 1, 17, 26, and 37 including:

"a first Ethernet packet from an originating device, the first Ethernet packet comprising a second Ethernet packet ... wherein a destination address of the second Ethernet packet is an address of the originating device," as recited in independent claim 1;

"the first Ethernet packet comprising a second Ethernet packet having a header pre-populated with an address of the originating device as the destination address, ... " and " returning the second Ethernet packet to the originating device, wherein the returned second Ethernet packet includes the pre-populated header and the encrypted packet data," as recited in independent claim 17;

"generating a first Ethernet packet, wherein the first Ethernet packet includes a header having an address of the originating device as the destination address and packet data ... generating a second Ethernet packet encapsulating the memory address and the first Ethernet packet, wherein the second Ethernet packet includes a header having an address of the security processor as the destination address, ...," as recited in independent claim 26;

and "a first Ethernet packet received from an originating device, the first Ethernet packet comprising a second Ethernet packet including a header having an address of the originating device as the destination address ..." and "a unit configured to transmit the second Ethernet packet, including the at least a portion encrypted by the encryption processor, to the originating device" as recited in independent claim 37.

Furthermore, these claims and their associated dependent claims are clearly supported by the specification and are therefore not indefinite. Based on the above, Applicants respectfully request that the objections to the specification and rejection of the claims under 25 U.S.C 112 first and second paragraphs be withdrawn.

2. Rejections under 35 U.S.C. §103

Claims 1-4, 13-15, 16, and 37 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Bryers *et al.*, U.S. Patent Published Application No. 2003/0126233 ("Bryers"), in view of Hadzic, U.S. Patent No. 7,130,303 ("Hadzic"), and in further view of Mercer *et al.*, U.S. Patent Published Application No. 2003/0018908 ("Mercer").¹ Claims 5-7, 9 were rejected under 35 U.S.C. § 103(as) as allegedly being unpatentable over the combination of Bryers, Hadzic, and Mercer, and in further view of Stevens, *TCP/IP Illustrated* ("Stevens"). Applicants respectfully traverse these rejections. Applicants note that the Examiner has not presented a rejection under 35 U.S.C. 103 for claims 17-33, 35, 36, or 38-40.

The combination of Bryers, Hadzic, and Mercer fails to teach or suggest each and every feature of amended independent claims 1 and 37. The Final Office Action acknowledges that Bryers fails "to explicitly recite that one Ethernet packet may comprise another Ethernet packet." The Office Action alleges that Hadzic "discloses the practice of generating an Ethernet packet comprising another Ethernet packet for delivery over large distributed systems." As explained in Applicants' Reply to the Non-Final Office Action, Hadzic describes "encapsulating contents of each original Ethernet packet, which originates in a first Ethernet network of an entity, e.g., an enterprise, a customer, or a network service provider, within another Ethernet packet which is given a source address that identifies the new encapsulating packet as originating at a port of a switch that is located at the interface between the first Ethernet network in which the original Ethernet packet originated and a second Ethernet network, e.g., the metropolitan area Ethernet network, which is to transport the encapsulating packet" to the destination. (Hadzic, 1:44-53.) Thus, Hadzic describes the use of encapsulation for transporting

¹ Applicants note that the Examiner did not include claims 13-15 and 37 in the summary statement regarding 35 U.S.C. §103(a) rejections, but did include arguments as why these claims were unpatentable under 35 U.S.C. §103. Therefore, Applicants have demonstrated that these claims should be allowed.

packets from an originating network to a destination network via an intermediate network, such as a metropolitan area Ethernet network. Nowhere does Hadzic describe that “the first Ethernet packet [from an originating device] comprising a second Ethernet packet ... wherein a destination address of the second Ethernet packet is an address of the originating device” as recited in independent claim 1 or “the first Ethernet packet [from an originating device] comprising a second Ethernet packet including a header having an address of the originating device as the destination address,” as recited in independent claim 37.

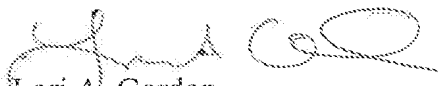
In the Final Office Action, the Examiner argues “that it may be possible to suggest that the applicant’s recitation of *wherein a destination address of the second Ethernet packet is an address of the originating device* is simply a reference to the fact that an address of a sender may be used by a receiver to send data to the sender.” (Final Office Action, p. 8.) Applicants respectfully disagree with the Examiner’s interpretation. The claims clearly recite that the second Ethernet packet is encapsulated in a first Ethernet packet. Furthermore, the claims clearly recite that the second Ethernet packet received from the originating device has the destination address set to the address of the originating device. The receiver does not have to generate a packet with the address of the sender to send data to the sender. Instead, the security processor (receiver) strips the first Ethernet packet and sends the second Ethernet (inner) packet back to the originating device.

Neither Mercer nor Stevens overcomes the deficiencies of Bryers and Hadzic relative to independent claims 1 and 37. Based on the above, Applicants respectfully request that the rejection of claims 1-4, 5-7, 9, 13-15, 16, and 37 be withdrawn.

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



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